

REMARKS

I. Status of the Claims

Claims 1-6 are currently pending and stand rejected in this application. Without prejudice or disclaimer, claim 1 has been amended herein. Support for this amendment can be found in the specification as filed, for example, at page 30, line 21 - page 31, line 3 and page 31, line 24 - page 32, line 2. Accordingly, Applicants submit that the above amendment raises no issue of new matter.

II. Rejections under 35 U.S.C. § 102(b)

A. U.S. Patent No. 5,462,683 to Kinoshita et al.

The Examiner maintains the rejection of claims 1, 3 and 6 under 35 U.S.C. § 102(b) over U.S. Patent No. 5,462,683 to Kinoshita (Kinoshita I). See Final Office Action at 2.

Specifically, the Examiner relies on Comparative Example 6 of Kinoshita I, and concludes that “[t]he example ... meets the limitations of claims 1, 3, and 6.” *Id.* Applicants respectfully disagree and traverse the rejection based on the following.

As amended, claim 1 recites “[a] grease composition **consisting essentially of** a lubricating base oil combined with (A) 2-30 wt% of a thickener and (B) 0.1-10 wt% of at least one type of compound selected from” *Id.* “The transitional phrase ‘consisting essentially of’ limits the scope of a claim to the specified materials or steps ‘and those that do not materially affect the basic and novel characteristic(s)’ of the claimed invention.” M.P.E.P. § 2111.03 8th Edition, August 2007 Revision (citing *In re Herz*, 537 F.2d 549, 551-52, (CCPA 1976)). For the previously stated reasons,

the compositions of Kinoshita I, which require boron nitride powders, cannot anticipate the grease composition of the claimed invention because boron nitride powders do not fall within the scope of a “consisting essentially of” claim.

Moreover, comparative example 6 of Kinoshita I, which lacks boron nitride powders, discloses 2.0 wt% of polysulfides as an extreme pressure agent. See col. 31, lines 1-15. However, amended claim 1 recites grease compositions optionally comprising extreme pressure agents “chosen from zinc dialkyldithiophosphates, zinc diaryldithiophosphates, zinc dialkyldithiocarbamates and zinc diaryldithiocarbamates, dihydrocarbyl polysulfide, sulfidized esters, thiazole compounds and thiadiazole compounds.” Thus, the polysulfides disclosed in the composition of comparative example 6 do not fall within the scope of extreme pressure agents currently claimed.

Accordingly, the compositions disclosed in Kinoshita I do not anticipate claims 1, 3 and 6 of the claimed invention and respectfully request withdrawal of the rejection.

B. U.S. Patent No. 5,516,439 to Takeuchi et al.

The Examiner maintains the rejection of claims 1-3 under 35 U.S.C. § 102(b) over U.S. Patent No. 5,516,439 to Takeuchi (Takeuchi) for the reasons set forth in the Office Action mailed August 8, 2007. See Final Office Action at 2. In that Office Action, the Examiner contended that “Takeuchi discloses a grease [composition] comprising a base oil, a lithium soap, an organic molybdenum compound, and a zinc dithiophosphate ...” and concluded that the “grease [composition] of Takeuchi therefore meets the limitations of claims 1-3.” *Id.* Applicants respectfully traverse and assert that this rejection is now moot in view of the amendment of claim 1.

The Examiner alleges on page 4 of the Final Office Action that “Takeuchi teaches in column 4 lines 14-28 that these metal salts are useful as rust inhibitors, which are a permitted component of the composition of amended claim 1... [and t]he metal salt-containing greases of Takeuchi therefore fall within the scope of amended claim 1.” *Id.* However, amended claim 1 recites rust inhibitors “chosen from metal soaps, polyhydric alcohol partial esters, amines, phosphoric acid and phosphoric acid salts,” and not metal salts, as required by Takeuchi. See, e.g., Takeuchi Abstract. Moreover, the claimed invention is not obvious in view of Takeuchi, because there is no teaching in Takeuchi to use anything other than a metal salt selected from the group consisting of metal salts of oxidized waxes, metal salts of petroleum sulfonates and metal salts of alkyl aromatic sulfonates to arrive at the presently claimed invention.

As Takeuchi does not disclose compositions comprising rust inhibitors currently claimed, and the compositions of the instant invention do not include a metal salt required by Takeuchi, Takeuchi fails to anticipate the present invention. Therefore, Applicants respectfully request withdrawal of the rejection.

C. U.S. Patent No. 5,569,643 to Kinoshita et al.

The Examiner rejects claims 1 and 4-6 under 35 U.S.C. § 102(b) over U.S. Patent No. 5,043,085 to Kinoshita et al. (Kinoshita II). See Office Action at 3. Specifically, the Examiner claims “examples 2 and 7-8 ... discloses grease compositions consisting of a lubricating oil, a thickener, and diphenyl hydrogen phosphite ... [and t]he composition of Kinoshita '085 therefore meets the limitations of claims 1 and 4-6.” *Id.* Applicants respectfully disagree and traverse the rejection for at least the reason that Kinoshita II fails to disclose in its compositions, the use of

specific rust inhibitors or extreme pressure agents presently recited in amended claim 1. Thus, Kinoshita II does not anticipate claims 1 and 4-6 of the present invention and Applicants respectfully request its withdrawal.

III. Conclusions

In view of the foregoing amendment and remarks, Applicants request reconsideration of the application and the timely allowance of the pending claims.

If the Examiner believes a telephone conference could be useful in resolving any of the outstanding issues, she is respectfully urged to contact Applicant's undersigned counsel at 202-408-4368.


If there is any fee due in connection with the filing of this Preliminary Amendment, please charge the fee to our Deposit Account No. 06-0916.

Respectfully submitted,

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